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10/065,120	09/18/2002	Scott C. Harris	GPSPrivC1	8217
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SCOTT C HARRIS			EXAMINER	
P O BOX 927649			ISSING, GREGORY C	
SAN DIEGO, CA 92192				
		ART UNIT	PAPER NUMBER	
		3662		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/065,120

Applicant(s)

HARRIS, SCOTT C.

Examiner

Gregory C. Issing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-7, 9-13, 15-20, 23-27, 51 and 52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 9-13, 15-20, 23-27, 51, and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10-13, 15, 17-20, and 52 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a “security part” using an override control button or an attachable RF blocking shield positioned in proximity to the positioning antenna to prevent the determination of position during an enhanced security mode, does not reasonably provide enablement “a testing part that tests a privacy of said communicating electronics.” The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The specification provides two embodiments for privacy control: first, via a manual override control button that prevents the automatic position sensing device from automatically determining position, and second, via a wrap-around plate that prevents the position sensing device antenna from receiving a signal. In each of these embodiments, the “security part” is a mechanical override control button or an attachable shield. The testing module operates during an enhanced mode defined by when the override button is pressed or the shield is attached to the device. The rejected claims are broader in scope than that which is described by the specification and thus, the scope of the claims are not commensurate in scope with the disclosed specification.
3. Claims 5-7, 10-13, 15, 17-20, and 52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. Claim 5 is considered new matter since the specification fails to provide a teaching, as required by 35 USC 112, of “using a test that is initiated from a remote location.”

5. Claim 10 is considered new matter since the specification, as originally filed, does not include testing the communication electronics. The specification does not provide a description of testing the position reporting communication but rather tests the position detection (see paragraphs [0014] and [0015]). The communication is described as not being disabled; Thus communication is not tested.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 9-13, 15, 17-19, and 51-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. In claim 9, the electronic device has a “position detection module.” The apparatus includes a “position privacy control.” However, the testing part describes “said position privacy module” which lacks a proper antecedent basis.

9. Claim 10 is indefinite since it is unclear what the scope of the “testing part” is since the specification is silent as to the testing the privacy of the communications electronics but rather is directed to testing the position detection. The scope of “a testing

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part that provides information . . . used to test a privacy of said communicating electronics” is indefinite and fails to clearly and distinctly define the subject matter.

10. Claim 15 is not clearly presented since “-52” is not clear. Additionally, the term “information” is indefinite since it is not clear to what this refers; claim 10 includes a part that “provides information” while claim 52 includes a device which “reports information”. This also exists in claim 17.

11. Claim 20 is indefinite particularly in relationship to the further limitations set forth by claim 23. In claim 20, the “position reporting control” is deemed to be supported by the override control button or shield as defined by the specification as originally filed. The electronics module of the electronic device is deemed to be shown by the communication electronics. Thus, the “position reporting device” lacks a proper antecedent basis and causes confusion as to what is controlled.

12. Claim 52 is lacks a proper antecedent basis for “said portable telephone” and “said telephone electronics”. The claim fails to clearly and distinctly define the subject matter particularly since it is unclear what the “reporting device” is and if and how it is different from the “communicating electronics” since the communications electronics further comprises the reporting device. Applicant is required to show where in the specification and drawings, the “reporting device” is described and/or shown and how it is different from the communications electronics which is described by the specification as a cellular phone.

13. Claims 1, 2, 4, 9, 10, 13, 20, 23, 24-27 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zellner et al (6,675,017) in view of Simms et al (5,334,974) and Mohan (6,121,922).

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14. The rejection is set forth in the previous Office Action (paragraph 9, pages 5-8). In summary, Zellner et al teach a method and system including a communicating device having a position detection module which determines a position and reports the position information to a remote object and a security part that is actuated to enhance security by preventing the position detection module from reporting its position but which allows the other parts of the electronic device to operate. Zellner et al do not teach or suggest testing the security part, i.e. do not teach or suggest whether the position reporting is working the way it is supposed to. Simms et al teach that it is desired to use testing of an integrated communication/position determining electronic device to test whether the various functions are working the way they are supposed to and providing an indication to the user of the status of the test, see Figure 6B, e.g. The various functions that are tested include the position determining function (560, 562, 564) and the communication function (554, 556, 558). Simms et al do not specify how the test is performed. Mohan suggests the testing of functions by comparing a transmitted message to a received message wherein the message includes position information.

15. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zellner et al by testing the functions of the integrated communication/position determining device, including the testing of the security part, i.e. the location blocking function, in view of the teachings of Simms et al, to assure the proper operation of the device. Moreover, it would have been obvious to one having ordinary skill in the art to test the function of the location blocking service via the use of a comparison of a transmitted message and a received message in view of the teachings of Mohan.

16. Applicant argues that there is no teaching or suggestion of testing whether the position detection has actually been prevented from reporting its position. Applicant also argues that any combination is based entirely on hindsight based on the teaching of the present invention. Applicant alleges that none of the KSR factors would be a proper basis for rendering the claims as obvious.

17. The applicants' arguments have been considered but are not persuasive. Zellner et al teach and suggest the desirability of privacy enhancement in an electronic device having location determining capabilities and communication capabilities wherein location is blocked from being reported to a remote location. Additionally, the prior art teach the testing of the operation of the various functions of an electronic device having both communication and location determining capabilities and thus suggests the desirability of testing the proper operation of functions therein. The combination therefore combines prior art elements, location determining incorporated within a communication device having as one of its functions the blocking of location reporting as shown by Zellner et al, according to known methods, testing of the proper operation of functions related to an integrated location determining wireless communication device as shown by Simms et al, to yield a predictable result, testing of the operation of the location blocking function designed for enhancing privacy. Additionally, Mohan shows the conventionality of testing via the comparison of a message transmitted to a remote location and a received message from the remote location to determine the proper operation of the device. The rejection is not based on improper hindsight since Zellner et al clearly suggest the desire to incorporate location blocking to enhance security and Simms et al clearly suggest the

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testing of operation of the various functions of an electronic device including the testing of the communication and the position determining functions.

18. Claims 11, 12, and 52 rejected under 35 U.S.C. 103(a) as being unpatentable over Zellner et al in view of Simms et al, Mohan and either one of Roeder or Altidor et al.

19. The rejection is substantially set forth above. Roeder and Altidor et al teach the conventionality of using a single button. Applicant argues patentability for reasons similar to the independent claims. The reasons for maintaining the rejection are set forth above with respect to the independent claims.

20. The rejections over Moles et al are withdrawn.

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (571)-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)-272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory C. Issing/
Primary Examiner
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gci